

REMARKS

Claim 15 has been amended to delete a redundant "and." No other claim has been amended. Claims 1-20 remain in the application. No new matter has been added.

Claim 1 stands finally rejected as allegedly being anticipated by Li et al. (US 6,219,793). Applicant respectfully submits that this rejection has been issued in error as Li et al. do not teach or suggest all of the claimed features of the invention.

In particular, Li et al. disclose a system in which a mobile telephone 102 includes a fingerprint scanner and an authenticated fingerprint from the user is required to authorize a wireless communication. In this fashion, only calls from authorized users are connected. In contrast, claim 1 relates to a method by which a first designated user provides gated access for *a third party* to a secure entity or service. In other words, a first designated user authorizes gated access by a different person to the secure entity or service. For example, as set forth in paragraph [0045] on page 15 of the specification, a stockbroker may use the claimed method to provide access to a computer network for his staff only during his presence. Li et al.'s system is designed to enable access to the wireless network by the person who provides his or her fingerprint at the fingerprint scanner on the mobile phone. Li et al. thus does not teach "providing a wireless gating signal for enabling wireless signals provided by the third party to access the secure entity or service said access provided for a predetermined, limited period of time" as claimed.

Applicant notes that Li et al. disclose an embodiment at column 15, lines 15-30, whereby multiple users may use the same wireless phone by storing challenge keys 202 for each user in the challenge key database at the mobile switching center. The phone owner may function as a "master user" who may allow other users to use his or her phone by activating appropriate buttons on the phone and associating the user's fingerprint with the master user's challenge key stored in the database at the mobile switching center. In other words, the master user can remotely authorize the use of his or her mobile phone by validating the use with his or her fingerprint. The second user would then use the wireless phone by swiping his or her fingerprint and proceeding to make a call once access is granted. Applicant submits that such teachings by Li et al. also fall well short of anticipating claim 1.

In particular, while Li et al. allow a first user to authorize secure access to a wireless network by a second user, no "wireless gating signal" is provided as set forth in claim 1. In fact, no access at all is provided until the second user is granted access upon fingerprint authentication and such access is not "gated" by the first user. The access control is provided by "activating appropriate buttons" at the wireless phone - not by sending a wireless gating signal "enabling wireless signals provided by the third party to access the secure entity or service ... for a predetermined, limited period of time" as claimed. In Li et al., once enabled, the access by the second party would be unlimited and not "wirelessly gated" as claimed. Withdrawal of the rejection of claim 1 as anticipated by Li et al. is thus appropriate and is respectfully solicited.

Claims 2-20 stand finally rejected as allegedly being obvious over Li et al. in view of Diamant et al. (US 5,969,632). Applicant respectfully submits that this rejection also has been issued in error as Li et al. and Diamant et al. together do not teach or suggest all of the claimed features of the invention and hence do not support a *prima facie* case of obviousness.

In particular, as noted above, Li et al. do not teach "providing a wireless gating signal for enabling wireless signals provided by the third party to access the secure entity or service said access provided for a predetermined, limited period of time" as claimed in each of the independent claims 1, 4, 11 and 15. Diamant et al. provide no such teachings either. On the contrary, Diamant et al. disclose a communication apparatus in which security flags may be set to on and off (Figure 8, steps 500 and 506). Applicant can find no teachings in Diamant et al. that teach or suggest the missing step of Li et al., namely, "providing a wireless gating signal for enabling wireless signals provided by the third party to access the secure entity or service said access provided for a predetermined, limited period of time." In the absence of such teachings, even if one skilled in the art would have been motivated to combine the teachings of Li et al. and Diamant et al. as the Examiner proposes, the claimed invention could not have resulted.

As set forth in M.P.E.P. §§2142-2143.03, in order to establish a *prima facie* case of obviousness, patent examiners are required to establish three criteria: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art

reference, or combination of references, must teach or suggest all the claim limitations. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To make a proper obviousness determination, the examiner must "step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." In view of the available factual information, the examiner must make a determination as to whether the claimed invention "as a whole" would have been obvious at that time to a person of ordinary skill in the art. Importantly, a rejection based on these criteria must be based on what is taught in the prior art, not the applicant's disclosure. The applicant's disclosure may not be used as a blueprint from which to construct an obviousness rejection.

Given that Li et al. and Diamant et al., taken separately or together do not teach or suggest all the claim limitations, the Examiner has not established a *prima facie* case of obviousness. Moreover, the Examiner has further failed to provide a *prima facie* case of obviousness with respect to any claim since the Examiner has not met his burden of providing a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. Instead, the Examiner has provided general references to preventing "hostile intrusion by unauthorized persons or data viruses" by combining the teachings of Li et al. and Diamant et al. However, the Examiner has provided no plausible reason as to why one skilled in the art would use the security flags of Diamant et al. in a system of the type disclosed by Li et al. Applicant suggests that no such motivation exists because security flags would serve no apparent purpose in the Li et al. system where the access by a third party is not gated as claimed and need not be "flagged" as claimed. As a result, one skilled in the art would not be motivated to combine the teachings of Li et al. and Diamant et al. to provide a "wireless gating signal for enabling wireless signals provided by the third party to access the secure entity or service said access provided for a predetermined, limited period of time" as claimed.

In view of the above, if the Examiner elects to maintain the obviousness rejection of claims 2-20, the Examiner is strongly urged to clearly articulate the evidence of suggestions, motivations, or knowledge possessed by those skilled in the art that would have led one skilled in the art to combine the teachings of Li et al. and Diamant et al. to arrive at the claimed invention. In the absence of the requisite teachings and motivations to combine

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teachings to establish *prima facie* obviousness, the rejection of claims 2-20 as being obvious over Li et al. and Diamant et al. is improper and withdrawal of the obviousness rejection is respectfully solicited.

In view of the above, Applicant submits that claims 1-20 are allowable over the art of record. Allowance of claims 1-20 is solicited.

Conclusion:

Entry of the above amendment in view of the above remarks is believed to place the present application in condition for allowance. Entry of the above amendment and issuance of a Notice of Allowability are respectfully solicited.

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